

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte AI-PING WEI and JAMES N. HERRON

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Appeal No. 2001-0496  
Application No. 08/891,114

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ON BRIEF

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Before ROBINSON, MILLS, and GRIMES, Administrative Patent Judges.  
ROBINSON, Administrative Patent Judge.

REQUEST FOR REHEARING

On July 30, 2001, Appellants filed papers denominated as a request reconsideration (rehearing) of the board's decision entered May 29, 2001 (Paper No. 39), wherein the examiner's rejections of the appealed claims 5 and 11 were reversed, the examiner's rejections of claims 1, 2, 4, 6 - 8, and 10 under 35 U.S.C. § 102 were

application PCT US94/08279, as originally filed on July 22, 1994, [did or] did not include broader claim language directed to 'nucleic acids' generically, rather than just DNA, and the material directed to nucleic acid may have been added by substitute sheet filed in August 1994." (Request, pages 1-2). As appellants acknowledge, modification of the earlier decision would not "obviate the rejections based upon . . . [Parkhurst II and Livak and ] does not change the ultimate outcome with respect to the non-allowability of presently worded claims 1 - 4 and 6 - 10 based on the other (i.e., Parkhurst I and Diamandis) art references." (Request, page 3).

As the declarations accompanying the Request would indicate there remains some ambiguity as to the content of the originally filed PCT application PCT US94/08279. However, as we pointed out in our Decision of May 29, 2001, the issue as to whether the claims on appeal were entitled to benefit of the filing date of the PCT application in question was not before us and was not considered in reaching our decision in the appeal. Therefore, it was not necessary for us to determine whether appellants claims on appeal were entitled to benefit of the filing date of the PCT application. The comments relating to this question were made in an effort to assist both the examiner and appellants should further prosecution occur in this application.

Appeal No. 2001-0496  
Application No. 08/891,114

respect to making any modifications to the decision affirming the examiner's rejections of claims 1 - 4 and 6 - 10.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REHEARING  
DENIED

DOUGLAS W. ROBINSON  
Administrative Patent Judge

DEMETRA J. MILLS  
Administrative Patent Judge

ERIC GRIMES  
Administrative Patent Judge

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Appeal No. 2001-0496  
Application No. 08/891,114

ALLEN C. TURNER  
TRASK BRITT & ROSSA  
P.O. BOX 2550  
SALT LAKE CITY UT 84110-2550

DWR/jlb